

REMARKS

Status of Prosecution

Claims 1-25 are pending in the present application.

In the Notice of Non-Compliant Amendment of July 21, 2008, the Examiner required correction of the drawings for not being properly identified in the top margin. Applicant has identified each drawing as a "REPLACEMENT SHEET" to correct the drawings. Further, Applicant has amended the Title to correct a spelling mistake.

In the Office Action mailed by the Examiner on January 28, 2008 the Examiner rejected claims 1-25 under 35 U.S.C. §103(a), arguing that the claims are obvious over Published U.S. Patent Application 2003/0144929 to Wakamatsu published on July 31, 2003 ("Wakamatsu Application") in view of U.S. Patent No. 6,282,274 to Jain, *et al.* issued on August 28, 2001 ("Jain Patent").

The Examiner also objected to dependent claim 6 because of a missing word. As indicated in the two Listings of Pending Claims beginning on page 4 of this paper, Applicants amended claim 6 to overcome the objection.

Replacement drawing sheets to convert approved but informal figures to formal figures are included. An Appendix including the replacement drawing figures is attached following page 22 of this paper.

Having respectfully replied to the Office Action, Applicants request that the Examiner withdraw both the objection and the rejections of the pending claims.

Rejections under 35 U.S.C §103(a)

In paragraphs 2-8 of the Office Action the Examiner rejected claims 1-25 under 35 U.S.C. §103(a), arguing that the claims are obvious over the Wakamatsu Application in view of the Jain Patent.

The Wakamatsu Application is sometimes referred to in this paper as the Primary Reference, and the Jain Patent as the Auxiliary Reference.

35 U.S.C. §103 provides:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Applicant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, neither the Primary Reference nor the Auxiliary Reference, alone or in combination, provides a *prima facie* basis for rejection of the claims under examination for at least the following reasons:

A. Primary Reference Fails to Satisfy the All-Elements Rule of MPEP §2131.

MPEP §2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference... The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

1. Absence of Identifier and Communication Type. The Examiner advances arguments invoking obviousness based on a combination of references. The Examiner is compelled to combine references because no single reference includes each and every element claimed by Applicants.

The Examiner concedes that the Wakamatsu Application, also referred to as the Primary Reference, fails to include the unique elements disclosed, illustrated, and claimed in the Application under examination. On page 3, paragraph 4 of the Office Action the Examiner expressly acknowledges that the Primary Reference “does not expressly show the identifier being assigned a communication type and the account being associated with a communication type.” Applicants agree with that observation. Applicants have underlined the conjunctive “and”

between “communication type” and “the account” because it will become evident that neither the Primary Reference nor the Auxiliary Reference, alone or in combination, disclose that combination of elements.

The Examiner argues, however, that the Jain Patent, also referred to as the Auxiliary Reference, “shows an identifier being assigned a communication type and an account being associated with a communication type (abstract).” Applicants presume that the parenthetical reference to “abstract” is the Examiner’s shorthand way of expressing that the communication type and the account associated with the communication type are shown only in the abstract of the Auxiliary Reference.

Applicants respectfully disagree with and traverse the Examiner’s argument.

The Examiner apparently seeks to equate the unique features and elements of the Application under examination with unrelated features and elements in the Primary and Auxiliary References.

The Application under examination claims an “identifier, the identifier identifying a digital processing device....” See Application, independent claim 1, page 16. As has been conceded by the Examiner, it is true that the Primary Reference does not expressly show an identifier being assigned a communication type and an account being associated with a communication type. But it is also evident that the Primary Reference does not show or claim an identifier that identifies a digital processing device.

The Examiner argues that the Auxiliary Reference fills the voids in the Primary Reference. However, the Auxiliary Reference claims only “a network resource allocation designator.” See Jain Patent, column 12, lines 23-24. The designators of the Jain Patent, and the identifier of the Application under examination, are dissimilar and unrelated. The “designator” of the Jain Patent is not used to identify a digital processing device. In addition, the conjunctive aspects and features of the Application under examination also are absent from the Jain Patent: not only does the identifier in the Application identify a digital processing device, the identifier is further assigned a communication type (business, personal, etc.). See Application, page 16, claim 1.

In neither the Primary nor Auxiliary Reference is there a suggestion of (a) an identifier (b) that identifies a digital processing device and (c) is further assigned a communication type.

The abstract of the Jain Patent, on which the Examiner relies for support, states that calls “may be distinguished...by the call originator” into business and or personal categories. The

identifier of the Application under examination, however, claims that the identifier not only identifies a digital processing device, it also is assigned a communication type. See Claim 1, page 16. The classifications by communication type are automatic, not merely an option. That feature is consistent with at least one objective of the Application under examination: “[T]here is a need for vehicle owners to distinguish between personal and business use of the MCT [mobile communication terminal] so that vehicle operators can be billed for their personal data networking usage.” See Application, page 2, paragraph [0005].

Therefore, the Examiner’s assertion that it would have been obvious to a person skilled in the art at the time of the invention to modify the billing service apparatus of the Primary Reference as taught by the Auxiliary Reference is unsupported.

2. Absence of a Processor for Receiving a Data Packet. The Examiner also seeks to assert, as the Examiner must to support arguments using the cited references, which the Wakamatsu Application discloses the processor disclosed, illustrated and claimed in the Application under examination.

More specifically, the Examiner argues that the Wakamatsu Application “shows” an apparatus that includes “a processor for receiving a data packet, the data packet comprising an address, the processor for comparing the address to the identifier and for adjusting an account if the address matches the identifier,” citing paragraphs [0027] and [0116] of the Wakamatsu Application.

Applicants respectfully disagree with and traverse the Examiner’s argument.

To the contrary, nothing in the Primary Reference “shows” a (i) processor (ii) for comparing the address to the identifier (iii) and for adjusting an account if the address matches the identifier. Certainly paragraphs [0027] and [0116] of the Wakamatsu Application fail to do so.

Paragraphs [0027] merely recites that in the “twelfth mode” of the Wakamatsu invention, the “identifying information” is one of three kinds of addresses.

Paragraph [0116] of the Primary Reference begins with the predicate, “[I]f necessary for billing...” Billing, however, is the stated goal and objective of the Application under examination. The language and phrasology of paragraph [0116] of the Primary Reference is muddled, but appears to include no suggestion or teaching of adjusting an account if an address matches an identifier.

Accordingly, the Examiner's argument that the Wakamatsu Application shows an apparatus that includes a processor for receiving a data packet, the data packet comprising an address, the processor for comparing the address to the identifier and for adjusting an account if the address matches the identifier, is unsupported.

3. Absence of Second Account. The examiner correctly concedes that the Wakamatsu Application fails to "expressly show billing a second account, the second account associated with a second type of communication, if the address does not match the identifier." See Office Action, page 3, paragraph 6.

Unable to find support for the unique features of the Application under examination in either the Primary or Auxiliary References, the Examiner resorts to implication rather than express recitals. The Examiner argues that the Jain Patent provides itemization by service account, which "implies" that "when an initial address-identifier pairing fails, subsequent pairings, including a 'second' pairing, are conducted until a match is found." See Office Action, page 3, paragraph 6. The implication is an impermissible inference by the Examiner, unsupported by any evidence.

The Examiner's inference has the ring of inherency unsupported by evidence. As noted by the CAFC, arguments having the ring of "common knowledge" do not establish a *prima facie* case of obviousness. What must be shown is the "specialized knowledge and expertise contemplated by the Administrative Procedures Act." See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

4. Not Well Known in the Art. On page 4, paragraph 8, carried-over to page 5, the Examiner further concedes that the combination of the Primary and Auxiliary References fails to show other unique features of the Application under examination.

For example, neither of the two cited references teaches what happens if a data packet is not forwarded to the digital processing device if the address does not match the identifier. Neither of the two cited references teaches use of a transceiver for transmitting a message to an originator of the data packet.

The Examiner, therefore, is forced to rely on the argument that such features are "well-known in the art."

Applicants respectfully disagree with and traverse that argument.

As the U.S. Supreme Court has observed, “[k]nowledge after the event is always easy, and problems once solved present no difficulties....” *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, at 435-436 (1911). The Supreme Court further noted that patent law “has other tests of the invention than subtle conjectures of what might have been seen and yet was not...” *Diamond Rubber Co.*, 436.

The Board of Patent Appeals and Interferences, since the decision of *In re Sang-su Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434-1435 (CAFC, 2002), has held several times that it is improper for an examiner to hold claims unpatentable for obviousness based solely on conclusory statements about what is “common knowledge” or “well known” in the art, without objective evidence in support of that knowledge. There is no evidence directing a person of ordinary skill in the art to combine such features with the other unique features of the Application under examination.

B. No Suggestion, Teaching, or Motivation to Combine. As stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....” (Emphasis added) As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

On April 30, 2007 the U.S. Supreme Court issued its opinion in *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (“KSR Opinion”).

On May 3, 2007 the Commissioner of Patents sent a memorandum to the Technology Center Directors that the KSR Opinion (a) reaffirmed the *Graham* factors, (b) did not reject the use of “teaching, suggestion, or motivation” (“TSM Test”) as a factor in the obviousness analysis, but merely rejected a rigid application of the TSM Test, and (c) reaffirmed the need to identify explicit reasons that would have prompted a person of ordinary skill in the art to combine the prior art elements in the manner suggested by an Examiner.

The Examiner has not offered explicit reasons why a person of ordinary skill in the art would seek to combine the references as suggested by the Examiner. Accordingly, Applicant

submits that a *prima facie* case for obviousness does not arise from a combination of the references cited by the Examiner.

Nothing identified by the Examiner in the Primary Reference or in the Auxiliary Reference supports a *prima facie* case of obviousness based on the standards of MPEP §706.02(j). Specifically, the Examiner has not shown explicit the reasons that would have prompted a person of ordinary skill in the art to combine the prior art elements in the manner suggested by an Examiner.

In addition, nothing in either reference teaches or suggests the combination urged by the Examiner.

C. No Support for Obviousness under the “Simple Substitution” Test of KSR.

In its KSR opinion the Supreme Court also stated that “when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one” and “if a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.” Having advanced that observation, however, the Court conceded that using those concepts “may be more difficult in other cases than [in KSR] because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” See KSR, 127 S.Ct. at 1735.

The Supreme Court’s recognition of the problem is consistent with the rule that references may not be modified or combined if their function is destroyed. See MPEP §2143.01. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Because the Primary Reference teaches a an internet use charging system (see face sheet of the Wakamatsu Application, the title), but the Auxiliary Reference teaches only selectable billing options for a single communications account (see face sheet of the Jain Patent, the title), combining either reference with the other would necessitate a change in the principle of operation of either such other reference.

The case example provided in MPEP §2143.01 supports Applicant’s position. In that example, the reference required rigidity for operation, whereas the claimed invention required

resiliency. In that case, the Court reversed the rejection stating that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” The same situation clearly applies to the references cited by the Examiner. Thus, it is respectfully submitted that modifying either of the references in view of the other is improper as provided in MPEP §2143.01.

Accordingly, the assertion of obviousness in this case must also be withdrawn because the claimed subject matter in the Application involves far more than the simple substitution of one known element for another.

In addition, a *prima facie* case of obviousness has not been established because the claimed subject matter in the Application clearly is not the mere application of a known technique to prior art ready for improvement.

D. No Support for Obviousness under the “Reason to Combine” Test of KSR. The Supreme Court also stated in KSR that “often it will be necessary... to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent [application] at issue.” (KSR, emphasis added.)

As indicated above, hardly any of the unique elements and features of the Application under examination are included in the Primary Reference; and the Auxiliary Reference, as shown, certainly does not supply the missing elements.

In addition, the Examiner has advanced no apparent reason to combine the elements in the fashion claimed by Applicant. See §2131).

E. Failure of Common Sense. The Supreme Court also stated in KSR that common sense teaches that familiar items “may have obvious uses beyond their primary purpose.”

Although true that common sense is the most uncommon of senses, it is evident that the fact that familiar items may have obvious uses beyond their primary purpose does not mean that a person skilled in the art would be motivated to combine elements in the manner of Applicant’s method and apparatus for providing separable billing services .

“Most if not all inventions arise from a combination of old elements...Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art

of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). Or, as restated by the KSR Court, “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense [presumably common sense], is already known.” See *KSR* at 15.

Thus, the common sense urged by *Kotzab* and *KSR* indicate that that the Examiner has not established a *prima facie* case for obviousness.

F. Hindsight Bias. The KSR Court also reconfirmed the importance of not “falling prey to hindsight bias.” See *KSR*, at 17, and MPEP §2143, second paragraph.

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Examiners are to “be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, id. Examiners are to avoid the “temptation to read into the prior art the teachings of the invention in issue,” *KSR*, at 17, citing *Graham*, 383 U.S. at 36.

G. Dependent Claims. Regarding the rejection of dependent claims, in view of the foregoing demonstration of the patentability of independent claims, the dependent claims are, of course, also patentable because they are directly or indirectly dependent on independent claims. Under 35 U.S.C. §103, as provided in MPEP §2143.03, if an independent claim is nonobvious under §103, then any claim depending therefrom is also nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

H. Conclusion. For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the objection and the rejections because all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited.

Drawings

Applicant files herewith formal drawings to replace the originally filed informal drawings.

Applicant submits that the above amendments to the drawings do not make any substantive changes or introduce any new material but simply render the application in better condition for allowance. The formal drawing figures are consistent with the specification as originally submitted. Therefore, approval and entry of the above amendments are respectfully requested.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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APPENDIX

Replacement formal drawing sheets follow this page.